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10/500,149

04/28/2005

Michael Herzog

HERZ3001/FJD

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BACON & THOMAS, PLLC  
625 SLATERS LANE  
FOURTH FLOOR  
ALEXANDRIA, VA 22314-1176

EXAMINER

KOO, GARY J

ART UNIT

PAPER NUMBER

2168

MAIL DATE

DELIVERY MODE

06/17/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/500,149 | <b>Applicant(s)</b><br>HERZOG, MICHAEL |  |
|                              | <b>Examiner</b><br>GARY KOO          | <b>Art Unit</b><br>2168                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-28 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-28 and 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/23/2011</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Claims 19-28 and 30-36 are pending.
2. Claims 19-28 and 30-36 are rejected.

***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/22/2011 has been entered.

***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on 03/23/2011 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 19 recites the limitation "querying the two databases" in the claim limitations. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, the examiner is interpreting this limitation as "the information".

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The remainder of the claims depend from claim 19, do not remedy the deficiency, and are rejected for the same reason.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 19-28 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by DeWolf et al. (US 2002/0032626 A1).

***As per claim 19, DeWolf teaches:***

- 19. A method for maintaining a production installation in the technology of automation and process control, having a plurality of field devices, whereby each field device determines or controls a process variable, whereby said field devices are partly, or completely, connected over a data bus with a control system, comprising the steps of:*** (DeWolf, [0009], "The present invention relates to networked computer systems and methods for asset registration and for conducting business (e.g. across a network) regarding the assets.")
- electronically registering the field devices in a manufacturer database with a manufacturer-specific identification and manufacturer-specific information relevant for the maintaining of the production installation,*** (DeWolf, [0012],

"Ownership and other attributes of "objects," including digital objects may be captured in a single, inter-operable database or in multiple and distinct databases or both. A GAIR contains, among other data, data regarding the object, producer, the owner and other agencies or individuals with a stockholder's interest in the same.")

***- whereby the manufacturer-specific information is only accessible to the***

***manufacturer*** (DeWolf, [0092], "The invention anticipates that given the critical need to have some records of ownership be public, and some private that various embodiments of GAIR would incorporate robust and state of the art security.")

***- and whereby the manufacturer-specific information contains information about***

***spare-parts or information when the production of each of the field devices will end;*** (DeWolf, [0107], "These records would be used subsequently for purposes such as ... repair and replacement part identification and procurement")

***- electronically registering the field devices in a customer database with a customer-specific identification and customer-specific information,*** (DeWolf, [0008],

"The present invention provides a method and system for attributing ownership of an asset or property to an individual, groups of individuals or other entities, as well as maintaining an up-to-date status regarding relevant attributes of the asset.

In one embodiment of the present invention, a single interoperable database would comprise all possible forms of ownership and other attributes regarding each asset. The database would be broadly available across computer networks, such as the Internet, and would provide for interfaces with commonly used computer applications, such as Internet Browsers. In this embodiment, the registry

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would allow for all forms of individuals or organizations to participate in the registry. This includes participation not only of owners, producers, sellers, financiers, and insurers, but also allows for participation of organizations that have an interest in asset ownership and other attributes, including law enforcement agencies, courts of law, legislative bodies, and regulatory agencies. The registry would provide for methods of conducting transactions that alter the state of ownership and other attributes of the asset. The system would also generate and incorporate documentation related to the above.")

***- whereby the customer-specific information is only accessible to the customer;***

(DeWolf, [0092], "The invention anticipates that given the critical need to have some records of ownership be public, and some private that various embodiments of GAIR would incorporate robust and state of the art security.")

***- and electronically querying the two databases on the basis of maintenance***

***criteria,*** (DeWolf, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

***- whereby the query determines the optimal stock of the spare parts or consumable***

***materials inventory for the chosen maintenance strategy.*** (DeWolf, [0076], "In an example embodiment, the creation and use of a common, inter-operable source allows for efficiencies to be gained in every component part of the practices currently used.")

***As per claim 20, the rejection of claim 19 is incorporated and further DeWolf teaches:***

- 20. The method as claimed in claim 19, wherein: the manufacturer-specific identification is the serial number of the field device.*** (DeWolf, [0045], "Typically assets are defined by a set of device dependent common characteristics, which include but are not limited to: ... serial number")

***As per claim 21, the rejection of claim 19 is incorporated and further DeWolf teaches:***

- 21. The method as claimed in claim 19, wherein: the customer-specific identification is the tag number of the field device.*** (DeWolf, [0045], "Typically assets are defined by a set of device dependent common characteristics, which include but are not limited to: ... registration number")

***As per claim 22, the rejection of claim 19 is incorporated and further DeWolf teaches:***

- 22. The method as claimed in claim 19, wherein: the maintenance criteria include corrective maintenance, replacement or preventive maintenance.*** (DeWolf, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and

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service schedules, and much if not all of the supply chain management and logistics of assembly.")

***As per claim 23, the rejection of claim 19 is incorporated and further DeWolf teaches:***

***- 23. The method as claimed in claim 19, wherein: the database querying yields a maintenance plan.*** (DeWolf, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

***As per claim 24, the rejection of claim 23 is incorporated and further DeWolf teaches:***

***- 24. The method as claimed in claim 23, wherein: the maintenance plan is stored in a maintenance database and every separate point of the maintenance plan is confirmed or modified by the customer before the storing.*** (DeWolf, [0049], "Transactions 210 may be associated with documents 220 and vice versa. Documents 220 may include but are not limited to ... maintenance records")

***As per claim 25, the rejection of claim 19 is incorporated and further DeWolf teaches:***



- 25. The method as claimed in claim 19, wherein: the manufacturer database also includes foreign devices of other manufacturers.** (DeWolf, [0040], "In a preferred embodiment, any individual or organization who entered data pertaining to an asset would always have access to that data. For example, a parts provider would always have access to their data (i.e., the assets the parts were in). For example, a tire manufacturer would have access to the GAIR 100 to identify all vehicles that their tires were installed on")

**As per claim 26, the rejection of claim 25 is incorporated and further DeWolf teaches:**

- 26. The method as claimed in claim 25, wherein: the manufacturer database (HG-DB), or portions thereof, come from Internet databases.** (DeWolf, [0008], "The database would be broadly available across computer networks, such as the Internet")

**As per claim 27, the rejection of claim 19 is incorporated and further DeWolf teaches:**

- 27. The method as claimed in claim 19, wherein : the time required for the maintenance of the field devices is stored in said manufacturer database and from this information, combined with the maintenance plan, projected costs of maintenance work are calculated.** (DeWolf, [0113], "Other manufacturers could use the GAIR to more accurately forecast failures and other expected costs (such

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as would be involved in recalls, warranty "actuarial" analyses, parts and service evaluations, etc.).")

*As per claim 28, the rejection of claim 19 is incorporated and further DeWolf teaches:*

*- 28. The method as claimed in claim 19, wherein: already-experienced, actual expenses of the maintenance work for the field devices are stored in said customer database and a projected versus actual cost comparison is produced for the maintenance plan.* (DeWolf, [0113], "Other manufacturers could use the GAIR to more accurately forecast failures and other expected costs (such as would be involved in recalls, warranty "actuarial" analyses, parts and service evaluations, etc.).")

*As per claim 30, the rejection of claim 19 is incorporated and further DeWolf teaches:*

*- 30. The method as claimed in claim 19, wherein: the customer database is supplemented and modified by the operator itself of the production installation, via Internet access.* (DeWolf, [0015], "In one embodiment, the asset registry would be broadly accessible across an electronic network. This would be accomplished, in part, through the use of generic or common software tools such as WWW browsers, Web Servers and Internet Transfer Protocols or other like computers and networks.")

*As per claim 31, the rejection of claim 30 is incorporated and further DeWolf teaches:*

- 31. The method as claimed in claim 30, wherein: the operator receives automatically and via Internet a maintenance plan adapted to a changed inventory of field devices or changed requirements for the maintenance strategy.* (DeWolf, [0015], "In one embodiment, the asset registry would be broadly accessible across an electronic network. This would be accomplished, in part, through the use of generic or common software tools such as WWW browsers, Web Servers and Internet Transfer Protocols or other like computers and networks.")

*As per claim 32, the rejection of claim 19 is incorporated and further DeWolf teaches:*

- 32. The method as claimed in claim 19, wherein: device type managers (DTMs) are stored in said manufacturer database and are included in the maintenance plan in execution specifications intended for the maintenance personnel.* (DeWolf, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

*As per claim 33, the rejection of claim 32 is incorporated and further DeWolf teaches:*

- 33. *The method as claimed in claim 32, wherein: electronic aids used for the maintenance are automatically adjusted by the maintenance plan.* (DeWolf, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

*As per claim 34, the rejection of claim 19 is incorporated and further DeWolf teaches:*

- 34. *The method as claimed in claim 19, wherein: the maintenance plan represents the control file for asset management systems.* (DeWolf, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

*As per claim 35, the rejection of claim 34 is incorporated and further DeWolf teaches:*

- 35. *The method as claimed in claim 34, wherein: control files for various asset management systems are produced by controlling the device type managers.*

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(DeWolf, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

*As per claim 36, the rejection of claim 19 is incorporated and further DeWolf teaches:*

- *36. The method as claimed in claim 19, wherein: a plurality of manufacturers support manufacturer databases in the Internet and, for each device in an installation, the appropriate link to the corresponding Internet address of the manufacturer database is contained in the device type manager of the particular device.* (DeWolf, [0008], "The database would be broadly available across computer networks, such as the Internet")

### ***Response to Arguments***

9. Applicant's arguments filed 01/20/2011 have been fully considered but they are not persuasive.

Argument 1:

The cited art does not teach "1) field devices used to determine or control a process variable (added by the present invention);"

Response 1:

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In response to applicant's arguments, the recitation "field devices used to determine or control a process variable" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Argument 2:

The cited prior art does not teach "2) utilization of the method in the process automation technology field;"

Response 2:

In response to applicant's arguments, the recitation "utilization of the method in the process automation technology field" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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Argument 3:

The cited prior art does not teach “3) the limitation that the manufacturer-specific information is only accessible to the manufacturer and that the manufacturer-specific information contains information about spare-parts or information when the production of each of the field devices will end;”

Response 3:

The examiner respectfully disagrees. As cited in the rejection, DeWolf teaches “(DeWolf, [0012], "Ownership and other attributes of "objects," including digital objects may be captured in a single, inter-operable database or in multiple and distinct databases or both. A GAIR contains, among other data, data regarding the object, producer, the owner and other agencies or individuals with a stockholder's interest in the same.)” and “(DeWolf, [0092], "The invention anticipates that given the critical need to have some records of ownership be public, and some private that various embodiments of GAIR would incorporate robust and state of the art security.")” Because some records are public, and some records may be private, information may be accessible to only specific parties.

Further, DeWolf teaches that this information may include information regarding spare parts. “(DeWolf, [0107], "These records would be used subsequently for purposes such as ... repair and replacement part identification and procurement")”

Argument 4:

The cited prior art does not teach “4) the limitation that the customer-specific information is only accessible to the customer;”

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Response 4:

See Response 3, above.

Argument 5:

The cited prior art does not teach "5) the limitation that the two databases are electronically queried on the basis of maintenance criteria, whereby the query determines the optimal stock of the spare parts or consumable materials inventory for the chosen maintenance strategy." The rejection misses the point of the present invention as recited in Claim 9 where two databases are established and queried and a conclusion reached. The two are not the same.

Response 5:

The examiner respectfully disagrees. Firstly, as reasoned in the 35 USC 112 rejection above, the examiner has interpreted the "two databases" limitation as "the information". However, as taught by DeWolf, the data may be "captured in a single, inter-operable database or in multiple and distinct databases or both." (DeWolf, [0012]) and any such queries on the information as taught by DeWolf would be run on several databases if such a configuration were chosen.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY KOO whose telephone number is (571)270-3887. The examiner can normally be reached on Monday to Friday 9:30am to 6:00pm (ET).



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary Koo/  
Examiner, Art Unit 2168

/TIM T VO/  
Supervisory Patent Examiner, Art Unit  
2168